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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,760	03/23/2001	Alan Derek Dean	78104123/N10817	7939
7590 10/19/2007 Intellectual Property Department DEWITT ROSS & STEVENS, S.C. Excelsior Financial Centre 8000 Excelsior Drive, Suite 401 Madison, WI 53717-1914			EXAMINER PATEL, HARESH N	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 10/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/815,760

Applicant(s)

DEAN, ALAN DEREK

Examiner

Haresh Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,10-12,14-16,18-20 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,10-12,14-16,18-20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 4-7, 10-12, 14-16, 18-20 and 23 are subject to examination. Claims 2, 3, 8, 9, 13, 17, 21, 22 are cancelled.

Response to Arguments

2. Applicant's arguments filed 8/3/07, pages 10-23, have been fully considered but they are not persuasive. Therefore, rejection of the claims is maintained (Note: amended claims 1, 7 and 23 are narrower as compared to previously presented claims 2, 3, etc respective claims).

3. Regarding the applicants' concern for the "partial entry", the examiner respectfully disagrees in response to applicant's arguments. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies, "partial entry (as argued against complete)", are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The First inquiry must be into exactly what the claims define. See *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970). What is claimed is, claims 1, 7 and 23, which is related to the "partial entry" arguments, "at least partial entry" with "comprising". Please refer to the below rejections of this office action for the limitations.

4. Regarding the applicants' concern for "automatically ..., without each individual providing name and known location data ...", the examiner respectfully disagrees in response to

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applicant's arguments. The MPEP 706.03 clearly cited usage of "the" and "said" versus not using "the" and "said" in front of the limitations. Since, "each individual" are claimed different, the interpretation of the broadly claimed subject matter is proper. Since, applicant's claims contain broadly claimed subject matter, it clearly reads upon the examiner's interpretation of these actions. Therefore, the rejection is maintained.

5. Regarding the applicants' concern for "both name and known location data", the examiner respectfully disagrees in response to applicant's arguments. The Agraharam-AT&T's disclose is not limited as concluded by the applicant as the reference not only support e-mail addresses including phone number but in various combination of e-mail addresses including the name information with the location information. Regarding the concluded Agraharm-AT&T's disclose, when reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. **In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963).** Skill in the art is presumed. **In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985).** Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. **In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962).** The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. **In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969).** Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

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In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977). Similarly applicant's assertion,

"Agraharam addresses this by appending the first names of the recipients, rather than adding any numeric code (see column 5 lines 24-37)" is incomplete because the appending in the reference is not meant to ignore numeric values. Therefore, the rejection is maintained.

Specification

6. As per the remarks dated 8/3/07, the title as per the claimed invention is suggested as :

"Standardized E-mail construction and search based on geographic location".

Drawings

7. The figure 3 submitted on 8/3/07 is acknowledged.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1, 4-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter.

Claim 1 and its dependent claims contain usage of "instructions operable to", which is not same as "instructions to" and hence do not implement collect, create etc., claimed subject matter, please see claim 1. Also, the instructions of the claimed invention (body of the claim) are not encoded in the program of the storage device. The applicant's citation of prior patents

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regarding “operable to” does overcome the rejection, one of the several reasons is that the mistakes of the prior patents need not be repeated, and the MPEP

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1, 4-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification of this application under examination in such a way as to reasonably convey to one skilled in the relevant art to use and/or make the invention.
10. The specification of this application under examination does not contain subject matter to implement amended limitations, “address including instructions operable to provide”, as cited in claim 1.
11. Claims 1, 4-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, i.e., “address including instructions operable to provide”, which was not described in the specification of this application under examination in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

12. Claims 1, 4-7, 10-12, 14-16, 18-20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 7 and 23, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 1, 7 and 23 recite the limitations, "the family name". There is insufficient antecedent basis for this limitation in the claim (Please see MPEP 706.03(d)). "Consider that individual's name inherently includes a family name", however, the assertion is incomplete, i.e., "Smith" is not inherent of "Joe".

Claim 1 recites the limitations, "to provide". These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim. It is not apparent to whom the personal name code and the location code are provided to, to accomplish the providing. Without having a receiving entity it is not possible to accomplish the providing. Since, this explanation is proper and the response does not overcome to whom the providing is done, this rejection is maintained.

Claims 1 and 7 recite the limitations, "the known location data". These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim, as per MPEP rules and guidelines, MPEP 706.03(d). Since, multiple "known location data" (without "the" or "said") exists in the claim, it is not clear which "known location data" is

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referred by the limitations in the claim. MPEP 706.03 clearly cited usage of “the” and “said” versus not using “the” and “said” in front of the limitations.

New claim 23 claims a system in the preamble, however the body of the claim contains steps. These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim.

Amended claim 7 contains multiple “and” before “wherein”.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 4-7, 10-12, 14-16, 18-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agraharam et al., 5,987,508, AT&T Corp., (Hereinafter Agraharam-AT&T) in view of “Official Notice”.

15. As per claim 1, Agraharam-AT&T discloses a program storage device readable by a machine and encoding a program of instructions for generating and providing access to a set of standardized electronic mail addresses for individuals in a geographic region (e.g., usage and handling of email addresses containing telephone number and user name for users including name of the user, family name of the user / various combination of the name and family name and the telephone number, figure 1, col., 5, lines 24 – 58, col., 5, lines 8 – 48, for example, usage

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of steve's phone number, name and family name in the email address), said instructions operable to comprising:

instructions operable to collect name and known location data of an individual from an information source (usage of geographical area information, col., 5, lines 8 – 48);

instructions operable to create an at least partial entry for the individual in an index of individuals in a database, the at least partial entry being based on the collected name and known location data of the individual (usage of database and alias addressing mechanism, directory, registry, col., 6, lines 6 – 67);

instructions operable to handle a standardized electronic mail address for the individual once both name and known location data have been collected (e.g., col., 1, lines 22 – 57) wherein the name data includes at least the family name of the individual and the location data includes a region specific portion of a telephone number (e.g., col., 5, lines 24 - 58)

the standardized electronic mail address including instructions operable to provide a personal name code indicative of the collected name data of a person the individual (e.g., usage and handling of email addresses containing telephone number and user name for users, figure 1, col., 5, lines 24 - 58); instructions operable to provide a location code indicative of the collected known location data of the individual (e.g., usage and handling of email addresses containing telephone number and user name for users, col., 3, lines 12 - 63); and instructions operable to have the standardized electronic mail address for said individual based on said the personal name code and said the location code (e.g., usage and handling of email addresses containing telephone number and user name for users, figure 1, col., 5, lines 24 - 58),

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instructions operable to submit the standardized electronic mail address for the individual to the database (e.g. to the database and alias addressing mechanism, directory, registry (col., 6, lines 6 – 67);

and instructions operable to search the database using the personal name code and the location code for the individual to locate the standardized electronic mail address of the individual (usage of database and alias addressing mechanism, directory, registry, col., 7, lines 8 – 61).

Agraharam-AT&T discloses specifically mention about trigger to generate email address and to automatically generate email address. “Official Notice” is taken that both the concept and advantages of providing trigger to generate email address and to automatically generate email address is well known and expected in the art. Pena, 6,292,211, discloses these well-known claimed limitations, col., 13, lines 39 – 67. Grauman, 6,707,472, discloses these well-known claimed limitations, col., 9, lines 36-45, figure 3. Hall 5,930,479, discloses these well-known claimed limitations, col., 5, lines 1 – 48. Ramey et al., 6,298,128 discloses these well-known claimed limitations, col., 2, lines 28 – 65). Toyoda, 6,897,985, discloses these well-known claimed limitations, col., 5, lines 2-38, col., 6, lines 2 - 26. Oseto 6,9097,797 discloses these well-known claimed limitations, col., 3, lines 2 – 48. Scroggie et al., 5,970,469, discloses these well-known claimed limitations, col., 9, lines 29 –41. Pennell et al., 2005/0125546, discloses these well-known claimed limitations, paragraphs 11 and 12. Dovolis, 2001/0034609, discloses these well-known claimed limitations, paragraph 39, abstract; Pennell et al., 6,874,023, discloses these well-known claimed limitations, paragraph 24; Szutu, 2001/0047391, discloses these well-known claimed limitations, paragraphs 11 and 12. Rudy et al., 6,360,252, discloses

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these well-known claimed limitations, col., 19, line 5 – 22, line 54 – col., 20, line 23. Yahoo People search, 02/08/1999, <http://people.yahoo.com>, discloses these well-known claimed limitations, pages 1 and 2. Lytle et al., 2003/0120737, Microsoft Corporation, discloses these well-known claimed limitations, paragraph 130. Kasso et al., 6,173,283, discloses these well-known claimed limitations, col., 2, lines 1 – 35. Brezin et al., 7,039,639, discloses these well-known claimed limitations, col., 4, lines 7 – 38. Brown, Nortel Networks Corporation, discloses these well-known claimed limitations, figures 1, 2, col., 4, lines 13 - 26. Kleinberg, 2001/0037265, discloses these well-known claimed limitations, figure 1, col., 3, lines 23 - 46. Siitonen et al., 6,049,796, discloses these well-known claimed limitations, abstract. Beck et al., 6,026,371, discloses these well-known claimed limitations, figure 3B, col., 4, lines 23 – 48.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include trigger to automatically generate email address and to generate email address with the teachings of Agraharam-AT&T in order to facilitate usage of the generating of the email address because the automatic generation would provide the email address. The well-known concept of automatic generating email address would provide email addresses that is used for communicating messages from one device to another. The motivation is obvious because without generating of the email address the email address would not exist. Agraharam-AT&T discloses usage and handling of email address that contain phone number with location information along with person's name, family name and/or various combination of the location information, name and family name, which would not exist without the email address being generated prior to the usage of the email addresses.

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16. As per claim 7, Agraharam-AT&T discloses the claimed limitations as rejected above. Agraharam-AT&T also discloses a system for generating and providing access to standardized electronic mail addresses for individuals in a geographical region the system comprising one or more computers configured to (e.g., figure 1, col., 2, lines 39 – 65), generate a standardized electronic mail address and a search engine for the rejected searching (e.g., figure 1, col., 2, lines 39 – 65).

17. As per claim 23, Agraharam-AT&T discloses the claimed limitations as rejected above. Agraharam-AT&T also discloses a system for generating and providing access to standardized electronic mail addresses for individuals in a geographical region, the system comprising one or more computers: collecting name data and location data of an individual from one or more preexisting databases (figure 1, col., 5, lines 24 – 58, col., 5, lines 8 – 48); creating an at least partial entry for the individual in an index of individuals in an index database, the at least partial entry being based on any name data and location data of the individual collected from the one or more preexisting databases (figure 1, col., 5, lines 24 – 58, col., 5, lines 8 – 48); having a standardized electronic mail address for the individual after the at least partial entry for the individual has been created in the index, wherein: (1) the standardized electronic mail address is containing (a) the collected name data includes at least the family name of the individual (col., 3, lines 12 - 63); and (b) the collected location data includes one or more of (i) a country specific postal address locator code such as a zip code, (ii) a region specific portion of a telephone number such as a telephone area code (col., 3, lines 12 - 63); (2) the standardized electronic mail address includes: (a) a personal name field, the personal name portion including at least a portion

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of the collected name data for the individual; (b) a location field, the location portion including at least a portion of the collected location data for the individual col., 6, lines 6 – 67); storing the standardized electronic mail address in the index database in association with the corresponding name data and location data for the individual; accepting search queries from users, the search queries including one or more of: (1) name data, and (2) location data, (col., 7, lines 8 – 61) and returning search results to the users, the search results including one or more standardized electronic mail addresses corresponding to one or more of the name data and location data accepted in the user search queries (col., 7, lines 8 – 61).

18. As per claims 4, 10, Agraharam-AT&T discloses the claimed limitations as rejected above. Agraharam-AT&T also discloses wherein standardized email address is for each individual in geographic region without each / the individual providing name and known location data to the program storage device / system (col., 5, lines 24 - 58).

19. As per claims 5, 11, Agraharam-AT&T discloses the claimed limitations as rejected above. Agraharam-AT&T also discloses wherein one or more subsidiary addresses, including existing electronic addresses, are associated with the standardized electronic mail address of the individual in the database (e.g., translation server email address and/or alias email address versus actual email address / country code specific address, col., 5, lines 8 – 65).

20. As per claims 6, 12, 16, 20, Agraharam-AT&T discloses the claimed limitations as rejected above. Agraharam-AT&T also discloses wherein the instructions are further operable to

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attach an identifier to the standardized electronic mail address of the individual (e.g., col., 5, lines 8 – 65). However, Agraharam-AT&T do not specifically mention about attaching a unique numeric identifier to the email address, after determining that the electronic mail address is non-unique. "Official Notice" is taken that both the concept and advantages of providing attaching a numeric unique identifier to the email address, after determining that the electronic mail address is non-unique is well known and expected in the art. For example, Scroggie et al., 5,970,469, discloses these limitations, creation of unique identification that also includes e-mail address, col., 9, lines 29 -41; Pennell et al., 2005/0125546, also discloses these limitations, usage of generation of an e-mail address that is having unique information, paragraphs 11 and 12. Dovolis, 2001/0034609, also discloses these limitations, usage of unique e-mail address and/or combination with other unique identifiers, paragraph 39, abstract; Pena, 6,292,211, also discloses these limitations, usage of creating an e-mail address for each subscriber and assigning a unique system access code, col., 13, lines 60 - 67; Pennell et al., 6,874,023, also discloses these limitations, usage of generating an e-mail address with a unique identifier, paragraph 24; Szutu, 2001/0047391, also discloses these limitations, usage of generation of an e-mail address that is having unique information, paragraphs 11 and 12.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include attaching a unique numeric identifier to the person's electronic mail address and after determining that the electronic mail address is non-unique attaching an indicator with the teachings of Agraharam-AT&T in order to facilitate making electronic mail address unique among other electronic mail addresses. By having a unique numeric identifier for each electronic mail address, it would help identify each electronic mail address differently from the other

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electronic mail addresses. The well-known concept of attaching unique numeric identifier would enhance making distinct email addresses.

21. As per claims 14, 18, Agraharam-AT&T discloses the claimed limitations as rejected above. Agraharam-AT&T also discloses wherein the instructions are further operable to provide the database of electronic mail addresses on-line (e.g., usage of directory assistance / Internet, col., 5, line 38 – 23).

22. As per claims 15, 19, Agraharam-AT&T discloses the claimed limitations as rejected above. Agraharam-AT&T also discloses wherein the instructions are further operable to locate the electronic mail address of the individual in the database (e.g., retrieval from the database / addressing mechanism, col., 6, lines 6 – 67).

23. As per claims 21, 22, Agraharam-AT&T discloses the claimed limitations as rejected above. Agraharam-AT&T also discloses handing of the email address when the data of the at least partial entry is sufficient (usage of database and alias addressing mechanism, directory, registry, col., 6, lines 6 – 67).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The arts cited in the "Official Notice" are pertinent to the claimed invention.

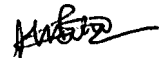
Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HARESH PATEL

PRIMARY EXAMINER

October 14, 2007